

125. (NEW) A method for processing a financial transaction using a wireless device comprising:
initiating a call to a financial services application;
selecting a desired type of product or service from a first list displayed on the wireless device, wherein the list of products and services are selected from a user profile associated with the wireless device;
selecting, from a second list displayed on the wireless device, a location where the selected type of product or service is offered;
selecting a particular point-of-sale terminal at the selected location;
10 receiving a transaction amount that is associated with the point-of-sale terminal, wherein the transaction amount is displayed on the wireless device; and
completing the financial transaction by approving the displayed transaction amount.

REMARKS

Claims 37, 38, 40, 47-49, 51, 57-62, 66, 71, 72, 75, 76, 78, 79, 83, 86, 91, 92, 94, 95, 97-100 and 106 -112 are addressed in the October 25, 2000 Office Action. In the present Amendment, Applicant has canceled claims 1-65, 67-70, 73, 74, 77, 80-82, 84, 85, 87-90, 93, 96 and 101-105; amended claims 66, 71, 72, 75, 86, 91, 92, 94, 98; and added new claims 113-125. Claims 66, 71, 72, 75, 76, 78, 79, 83, 86, 91, 92, 94, 95, 97-100 and 106-125 remain pending in the application. The outstanding issues in the present Office Action are:

- Applicant is requested to resend Form PTO-1449 and accompanying references;
- Claims 66, 71, 72, 75, 78, 79, 83, 86, 91, 92, 94 and 97-100 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite;
- Claims 38, 40, 57-59, 71, 72, 91, 92, 107, 109 and 110 are rejected under 35 U.S.C. § 112, first paragraph, as not being enabled;
- Claims 66, 71, 72, 86, 91 and 92 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter;
- Claims 37, 38, 40, 47-49, 51 and 57-62 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,878,337 to Joao et al. ("Joao"); and

- Claims 37, 38, 40, 47-49, 51, 57-62, 66, 71, 72, 75, 76, 78, 79, 83, 86, 91, 92, 94, 95, 97-100 and 106 -112 are rejected under 35 U.S.C. § 102(a) as being anticipated by PCT publication number WO 97/45814 by Vazvan (“Vazvan”).

Applicant submits that the pending claims are allowable in view of the arguments and amendments set forth herein.

Request for Form PTO-1449 and References

The Examiner has requested Applicant to resend Form PTO-1449 and the accompanying references. By separate letter, dated November 7, 2000, Applicant has resubmitted the Information Disclosure Statement and references.

Rejections under 37 U.S.C. § 112, Second Paragraph

The Examiner has rejected claims 66, 71, 72, 75, 78, 79, 83, 86, 91, 92, 94 and 97-100 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, independent claims 66 and 86 are rejected as vague because the body of the claim does not accomplish what is set forth in the preamble; and independent claim 98 is rejected because the “means for customer information element” is confusing. The other cited claims depend from claims 66, 86 or 98.

Applicant has amended independent claims 66 and 86 to recite a method and system, respectively, in which a transaction is initiated and controlled using a customer’s wireless device. The elements of the claims, as amended, recite features that are direct to such initiation and control of a transaction. Applicant submits that the claims as amended accomplish what is set forth in the preamble. Therefore, independent claims 66 and 86 and dependent claims 71, 72, 75, 78, 79, 83, 91, 92, 94 and 97 are allowable under 35 U.S.C. § 112, second paragraph.

Applicant has amended independent claim 98 to clarify that the recited “means” is a “means for receiving customer information from a wireless network.” Applicant submits that claim 98 is not confusing following this clarification. Therefore, claim 98 and dependent claims 99 and 100 are allowable under 35 U.S.C. § 112, second paragraph.

Rejections under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 38, 40, 57-59, 71, 72, 91, 92, 107, 109 and 110 under 35 U.S.C. § 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable on skilled in the art to make or use the invention. Claims 38, 40 and 57-59 have been canceled in the present Office Action. Accordingly, the rejection with respect to these claims is moot.

The following comments regarding the enablement rejection are found on page 3 of the Office Action:

These claims are related to the customer scrolling through a list of point of sale locations to enable the system to know the location of the terminal where they are transacting business. However, the specification is wholly deficient on describing how an antenna or cell site knows the location of all of the stores in its area, let alone all of the point of sale terminals in all of those stores, in order to display a scrolling menu of the locations to the customer. Are all of the individual stores and all of the terminals in those stores supposed to register with the service? If so, this is clearly not described in the specification in order to enable one of ordinary skill in the art to practice these claims.

M.P.E.P. § 2164.04 sets forth the burden on the Examiner under the enablement requirement - “Before any analysis of enablement can occur, it is necessary for the examiner to construe the claims.” Applicant submits that the Examiner has not explicitly set forth the meaning of the claim terms in the Office Action. Instead, the Examiner appears to be reading limitations into the claims. The Office Action states that the rejected claims “are related to the customer scrolling through a list of point of sale locations.” Claims 71, 91 and 98 do not require such a limitation, and the Examiner has not indicated which element has been interpreted to require this limitation.

The Office Action further states that “the specification is wholly deficient on describing how an antenna or cell site knows the location of all of the stores in its area.” However, none of the pending or canceled claims require the limitation that “an antenna or cell site knows the location of all of the stores in its area.” The enablement rejection as set forth in the present Office Action is directed to limitations that do not appear in the claims.

M.P.E.P. § 2164.08 states that “[t]he focus of the examination inquiry is whether everything within the scope of the claim is enabled.” Applicant requests that the Examiner

identify all of the claim terms that are construed to require “scrolling through a list of point of sale locations” and “an antenna or cell site knowing the location of all of the stores in its area.”

Applicant notes that not all of the cited claims require a determination of location within a certain cell site. For example, claims 66, 71, 72, 86, 91, 92 and 98 do not include such a limitation. In these claims, the point of sale location can be identified without requiring a cell-site identification. However, as a matter of record, Applicant asserts that these claims are broad to cover alternate embodiments that include, but are not limited to, cell-site identification.

After referring to additional limitations noted above, the enablement rejection states that “this is clearly not described in the specification.” Applicant understands this rejection to be based on the Examiner’s belief that certain information is missing in the specification. “In such a case, the examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation.” M.P.E.P. § 2164.04. Applicant notes that the Examiner has identified certain missing information, however, there is no discussion regarding “why one skilled in the art could not supply the information without undue experimentation.”

The test for enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. M.P.E.P. § 2164.01. Everything that is needed to practice the claims does not have to be disclosed. “In fact, what is well-known is best omitted.” M.P.E.P. § 2164.08. To the extent that the pending claims cover a system in which a customer scrolls through a list of point of sale locations or a system in which an antenna or cell site knows the location of all of the stores in its area, Applicant submits that the Examiner’s remarks in the Office Action indicate that these features are well-known and would not require undue experimentation to practice the invention.

The Office Action states that “the specification is wholly deficient on describing how an antenna or cell site knows the location of all of the stores in its area, let alone all of the point of sale terminals in all of those stores, in order to display a scrolling menu of the locations to the customer.” However, in the next sentence, the Examiner illustrates that this could be done without undue experimentation using well known methods: “Are all of the

individual stores and all of the terminals in those stores supposed to register with the service?" Clearly, as pointed out the Examiner himself, it would be obvious to one skilled in the art that the point of sale locations could be registered with the system so that their location would be known. Applicant submits that registration is well known, as shown by the Examiner's own statement, and that no undue experimentation would be required to use registration. Applicant notes that registration is not required in the claims and that there are other ways to identify the various point of sale locations as discussed below.

The patent specification discloses several methods for identifying, determining or selecting the point of sale locations, including the following:

The point of sale location can be identified by selecting from a series of menus presented on the wireless display or by entering a unique location identifier on the wireless device.

Page 4, lines. 9-11.

System 10 can identify the customer's geographic area by determining which antenna 19 is being used during the customer's call on wireless telephone 13. Once the geographic area is identified, system 10 can determine the point of sale locations 100 that are within the identified area. The size of the geographic area will vary depending upon wireless network 17. In most networks, antenna 19 will serve several square miles. In this situation, it is likely that many businesses will be within the area covered by antenna 19. However, future networks may have the capability to use pico cells that will serve a very small area. Pico cells will allow network 17 to place the customer in a very small geographic area and potentially link the customer to a particular point of sale location without additionally input from the user. Thus, a user may simply walk into a store, or walk up to a register, and enter a code in his/her wireless device. The system would then link that user to the register so that the specific transaction data can be entered.

Page 9, lines 14-28.

Display 15 on wireless telephone 13 presents the customer with a menu or list of potential sales locations 100. Of course, this menu could be an audible message that is broadcast to the listening user on device 13. The list of businesses can be derived using the geographic area of active antenna 19. For example, the customer could choose a display 15 so that only those point of sale locations within the area served by antenna 19 are displayed. In other cases, display 15 could show all point of sale locations. The customer, using

telephone 13, selects the appropriate location 100 from the menu on display 15. Depending upon the size of display 15 and the number of businesses displayed, the customer may have to scroll through one or more menu screens to find a particular point of sale location 100.

Page 9, line 29 - page 10, line 10.

One use of the personal profile would be to select the list of potential locations 100 that are displayed when the customer initiates a transaction. For example, if the customer has indicated that he/she prefers to shop at a particular chain of grocery stores or gas stations, then wireless network 17 can select the potential point of sale locations based upon the customer's preferences.

Page 12, line 30 - page 13, line 4.

Financial gateway 18 or wireless network 17 could monitor the statistical use of certain businesses and update customers' personal profiles accordingly. Using this information, the menu of point of sale locations 100 could list the businesses that the customer uses most often before listing other businesses in that geographic area.

Page 13, lines 11-15.

In a preferred embodiment, menu 401 lists several categories of the point of sale locations 100 that fall within the geographic area of the customer's cell site. In other embodiments, the customer's personal profile may cause the display to show all the point of sale locations in all categories or in certain categories without regard to whether they fall within a particular geographic area.

Page 15, line 17-23.

In the present example, the customer is at a gas station and desires to complete a transaction at a particular pump, so the "Gas Stations" category is selected on menu 401. This causes menu 402 to be displayed. The customer then selects a particular chain of gas stations to get menu 403 which shows the street addresses for that vendor's gas stations. The information in menu 403 may list a specific street address or it may list an intersection where a particular gas station is located. It will be understood that specific locations 100 can be identified in any number of ways in addition to the vendor's address.

After identifying a particular gas station, the customer then selects the correct gas pump from menu 404.

Page 15, line 25 - page 16, line 4.

The menus described above can be modified to present almost any sequence of information to the customer. In one embodiment, the customer could select "Point of Sale ID" from menu 401. This would present menu 407 which prompts the customer for the identifier of a specific point of sale terminal 11. For example, a unique number assigned to gas pump #3 at the gas station selected above, such as 9999. After the customer enters the terminal's identifier, the menu display could jump immediately to menu 405 where the customer is shown the transaction amount for that specific point of sale terminal 11 and asked to accept or reject the transaction. This would reduce the number of menus and increase the efficiency of system 10.

Page 16, lines 18-28.

For example, if a potential customer needed gas and desired to make a wireless financial transaction to purchase the gas, then by following the sequence in FIGURE 4 to display menu 403, the customer would receive a list of nearby gas stations that accept wireless financial transactions. In other embodiments, menu 403 could be modified to show all gas stations (or other business categories) in a certain geographic area. If there are no business of a certain category within the potential customer's geographic area, then menu 403 could display the closest business of that type.

Page 17, line 1-9.

Applicant submits that the above-quoted sections of the application provide sufficient enablement for one of skill in the art to make and use the claimed inventions without undue experimentation. Accordingly, the pending claims are allowable under 35 U.S.C. § 112, first paragraph.

Rejections under 35 U.S.C. § 101

The Examiner has rejected claims 66, 71, 72, 86, 91 and 92 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Specifically, the Examiner states that independent claims 66 and 86 "merely manipulate abstract ideas" without a practical application such as "charging" or "transmitting." Claims 66 and 86, as amended, include a practical application, such as "transmitting" or a "means for transmitting." Accordingly, Applicant submits that the cited claims are allowable under 35 U.S.C. § 101.

Rejections under 35 U.S.C. § 102(e)

The Examiner has rejected claims 37, 38, 40, 47-49, 51 and 57-62 under 35 U.S.C. § 102(e) as being anticipated by the Joao patent. Applicant has canceled claims 1-62 and, therefore, the rejection is now moot.

Rejections under 35 U.S.C. § 102(a)

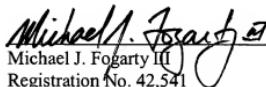
The Examiner has rejected claims 37, 38, 40, 47-49, 51, 57-62, 66, 71, 72, 75, 76, 78, 79, 83, 86, 91, 92, 94, 95, 97-100 and 106 -112 under 35 U.S.C. § 102(a) as being anticipated by the Vazvan PCT publication. The Vazvan reference was published on December 4, 1997. The systems and methods recited in the pending claims were invented prior to December 4, 1997, therefore, the Vazvan reference is not a valid prior art reference under 35 U.S.C. § 102(a). Applicant has attached herewith a Declaration under 37 C.F.R. § 1.131 to establish that the date of invention was prior to the publication date of the Vazvan reference. Accordingly, Applicant submits that the pending claims are allowable under 35 U.S.C. § 102(a).

New Claims

Applicant has added new claims 113 - 125 in the present Amendment. These claims are supported by the original specification as illustrated, for example, in sections of the specification that are quoted above. Applicants submit that the new claims are also allowable under 35 U.S.C. §§ 101, 102 and 112 for the reasons discussed above with respect to claims 66, 71, 72, 75, 76, 78, 79, 83, 86, 91, 92, 94, 95, 97-100 and 106-112.

Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,


Michael J. Fogarty III
Registration No. 42,541
Counsel for Applicant

Date: 1/25/01
Fulbright & Jaworski L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201-2784
Telephone: 214-855-8172
Telecopier: 214-855-8200